

In re Application of: **STAMFORD** et al.  
Serial No.: 10/026,651  
Filed: December 18, 2001

### **Remarks**

This paper is in response to the Final Official Action dated December 15, 2003, for the above-identified application. A response to the office action was originally due on March 15, 2004. Applicants are filing this response with a request for a two-month extension of time, herein attached, thus making this response due on May 15, 2004

Claims 1-4, 12-14, 21-29 and 31 are pending in the application. Claim 22 has been rejected. Claims 23-29 have been objected to. Claims 1-4, 12-14, 21-29 and 31 have been allowed. Applicants have canceled claim 24. Applicants have amended claim 22. No new subject matter has been added to the subject application with the filing of this response. Applicants reserve their right to file divisional applications on the subject matter that has been subject to restriction and continuation applications on the subject matter that has been deleted out of all currently amended claims.

### **Supplemental IDS**

Applicants are filing a reference via a Supplemental Information Disclosure Statement, to which applicants respectfully request the entry of said reference into the record. Applicants are filing a Request for Continued Examination to expedite the entry of said reference.

### **35 USC §112, First Paragraph**

The Examiner stated that claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the Examiner believes that the specification, while being enabling for eating disorders, does not provide enablement for any or all metabolic disorders including those yet to be discovered as due to NP Y Y5 receptor activity.

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The Examiner supported this position by citing the Wands factors, (see Ex parte Forman, 230 USPQ at 547; Wands, In re. 858.F. 2d 731. 8 USPQ 2d 1400. Fed. Cir. 1988)

In response, applicants have amended claim 22 by claiming those methods of treatment directed to "eating disorders" and "obesity and disorders related to obesity", thereby rendering the §112, first paragraph moot. Support for this amendment can be found on page 11, line 4 to page 12, line 2 of the specification. Applicants have canceled claim 24. Applicants therefore, respectfully request the withdrawal of this rejection.

#### **Allowable Subject Matter**

The Examiner stated that claims 1-4, 12-14, 21 and 31 are allowable. The Examiner stated that claims 23-29 and 31 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, applicants respectfully point out that they have amended the base claim 22, as suggested by the Examiner, in an effort to place the dependent claims in condition for allowance. Therefore, applicants respectfully request the withdrawal of this objection.

Applicants respectfully submit that in view of the above response, applicants have sufficiently addressed the Examiner's rejections, objections and that the application, as amended, is in condition for allowance.

If any additional fees are determined to be due by this paper, the Commissioner is hereby authorized to deduct such fees from **Account No. 19-0365**.

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The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted,



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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450 ON May 12, 2004.  
(DATE OF DEPOSIT)

William Y. Lee, REG. NO. 46,100  
(REGISTERED REPRESENTATIVE)



(SIGNATURE AND DATE)

WL  
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